

Appl. No. 09/625,573
Amdt. dated September 26, 2003
Reply to Office Action of June 30, 2003

PATENT

REMARKS/ARGUMENTS

The present amendment is submitted in accordance with the *Revised Amendment Format* as set forth in the Notice provided on the USPTO web site for the Office of Patent Legal Administration; Pre-OG Notices; signed 1/31/03.

Claims 2-19 are pending in the application. No claims are allowed. Claims 2, 9-17 and 19 have been amended. Claims 3-8 and 18 have been canceled. Claim 20 has been added. Entry of the amendment, reconsideration of the rejection, and allowance of claims 2, 9-17 and 19 are requested.

Applicants thank the Examiner for rejoining the restricted groups II and IV upon reconsideration. As such, group B (*i.e.*, group II and IV rejoined) drawn to claims 2-19 (each in part) to SEQ ID NO: 3 and 4 will be examined in this application.

Applicants gratefully acknowledge the telephone interview which was granted by the Examiner on September 23, 2003. During the interview, Applicants discussed primarily the term "specifically" as it relates to *specific binding* of an antibody to the MCP-1 receptor. The Examiner indicated in the Office Action that the term "specifically" in claims 2 and 3 is allegedly a relative term which renders the claims indefinite. Applicants have canceled claim 3. With respect to claim 2, the term "specifically" has been removed from the claims. However, it is stated for the record (as was agreed upon in the interview) that the term "binding" in the context of the present invention is a term of art which refers to the *specific binding* of an antibody to its cognate antigen, and that the deletion of "specifically" from the claims does not change the scope of the claims.

Information Disclosure Statement

The Office Action indicates that the information disclosure statement (IDS) filed on February 15, 2001 fails to comply with 37 C.F.R. §1.98(a)(2) which requires a legible copy of each listed reference; and that the references listed therein may be provided along with the response to the Office Action at no additional fee.

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Applicants thank the Examiner for offering to consider the references in conjunction with the response at no extra charge. An IDS (citing each reference that was originally cited on the IDS filed on February 15, 2001) as well as a legible copy of each of the references are attached to this response.

Oath/Declaration

The Office Action indicates that the oath or declaration is defective because it claims domestic priority to Application Serial No. 08/182,962 filed January 13, 1994 which is neither listed on the Application Data Sheet nor in the first line of the specification. Clarification is requested.

Applicants respectfully indicate that the specification has been amended on page 1, line 4 to clarify the priority claim (see page 2, "Amendments to the Specification"). As indicated, the instant application is a continuation of Application No. 08/446,669, filed January 11, 1995, now U.S. Patent No. 6,132,987, which is the National Stage of International Application No. PCT/US95/00476, filed January 11, 1995, which is a continuation-in-part of Application No. 08/182,962, filed January 13, 1994, now abandoned. In light of this amendment, a new declaration should not be required.

The Amendment

In order to expedite prosecution of the application and advance the case toward allowance, the claims have been amended according to the Examiner's suggestion. No new matter was introduced by this amendment.

The specification has been amended to correct for the missing space in "SciUSA" on page 30, line 20. In addition, Applicants note typographical errors on pages 45 and 46 in the "Discussion of Results" section (beginning at page 43, line 22) concerning the term "MCP-1 α /RANTES receptor" which have been corrected by this amendment. The correct term is "MIP-1 α /RANTES receptor" (emphasis added). Specifically, the errors occurred on page 45, lines 8, 12 and 14; and on page 46, lines 6 and 8. Applicants state for the record that these are clerical errors that occurred unintentionally. Support for "MIP-1 α /RANTES" can be found

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throughout the specification and notably in the title for Table I at page 42, at line 16 and the discussion before and after Table I.

The specification has also been amended to conform to the drawings as originally filed. These amendments eliminate the need for replacement formal drawings.

Claim 2 has been amended to delete the reference to non-elected matter (*i.e.*, SEQ ID NOS: 1 and 2); to delete the term "specifically", and to simplify the claim. Support for this amendment can be found on page 26, lines 1-2 and on page 27, lines 4-6.

Claims 3-8 have been canceled.

Claims 9-15, 17 and 19 have been amended to correct the claim dependency.

Claim 12 has also been amended to insert the word "the" before "antibody".

Claims 14 and 15 have also been amended to correct the spelling of eukaryotic and prokaryotic, respectively.

Claim 16 has been amended to replace the phrases "the antibody of claim 3" with the phrase "an antibody that binds MCP-1 receptor polypeptide" and to delete the term "specifically" in step (e). Support for this amendment can be found on page 27, lines 4-6.

Claim 19 has further been amended to delete the word "specific" before "specific binding"; and to add the word "the" before "binding fragment" to provide for clear antecedent basis.

Claim 20 has been added and depends from claim 16. Support for this claim can be found on page 8, line 21-23.

Claim Objections

The Office Action indicates that misnumbered claims 1-18 have been corrected as the numbering of claims was not in accordance with 37 C.F.R. §1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. Applicants thank the Examiner for the courtesy of correctly renumbering the claims as 2-19.

Claims 2-19 are also objected to because of reciting non-elected matter.

Applicants have amended the claims accordingly and deleted all references to non-elected matter.

Rejection under 35 U.S.C. §112

Claims 3-19 are rejected under 35 U.S.C. §112, first paragraph, because the specification allegedly is not enabling and does not provide written description for antibodies that bind polypeptides with at least 90% to 95% homology to SEQ ID NO: 4.

Applicants have canceled claims 3-8 and 18. Claims 9-17 and 19 have been amended and no longer depend directly or indirectly on claim 3. Thus, claims to antibodies that bind polypeptides with at least 90% to 95% homology to MCP-1 receptor polypeptide have been canceled. However, the amendment is made to expedite allowance and should not be construed as an acquiescence in the rejection. Applicants reserve the right to prosecute these claims in a related application.

In light of this amendment, the rejections are moot and Applicants respectfully request that the rejections of claims 9-17 and 19 under 35 U.S.C. §112, first paragraph, be withdrawn.

Claims 2, 3 and 13-15 are rejected under 35 U.S.C. §112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter.

Applicants have canceled claim 3. With respect to claim 2, Applicants have deleted the term "specifically" from the claim (*supra*, see Remarks section).

With respect to claim 13, the Examiner writes that claim 13 recites the limitation "the monoclonal antibody" in the first line with insufficient antecedent basis. Claim 13 has been amended to depend from claim 11 which recites "a monoclonal antibody". Further, the Examiner indicates that claims 14 and 15 recite the limitation "the cell line" in the first line and that there is insufficient basis for this limitation in the claim. Claims 14 and 15 have been amended to depend from claim 13 which recites "a cell line".

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In light of this amendment and the arguments presented above, Applicants respectfully request that the rejection of claims 2 and 13-15 under 35 U.S.C. §112, second paragraph, be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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